

REMARKS

The Office Action dated March 26, 2007 has been received and reviewed. This response is directed to that action. The applicants submit herewith a Petition for a One-Month Extension of Time.

Claims 1 and 4 have been amended and claim 2 has been cancelled. Support for the amendments to claim 1 can be found in claim 2 as originally filed. Replacement formal drawing sheets are submitted herewith in order to correct certain formal objections. No new matter is believed to have been added.

The applicants respectfully request reconsideration based on the foregoing amendments and the following remarks.

Objections to the Drawings

The Examiner objected to the drawings for failing to show every feature of the invention specified in the claims. Specifically, the Examiner stated that the “lid resting in its open position such that it prevents an aperture from coming into contact with a user’s top lip” must either be shown in the drawings or canceled in the claims. The applicants respectfully traverse this objection.

In the present application, the applicants submit that the drawings are presented to enhance and supplement the disclosure of the instant invention; they are not necessary for the understanding of the invention. Therefore, it is not necessary to include the above-stated limitation in Figure 1 to accord an understanding of the claim. Indeed, a person of ordinary skill in the art, after viewing the present Figure 1, would clearly understand exactly how the device would be held under the user’s nostrils, with the lid necessarily

resting on their top lip. Therefore, the applicants respectfully submit that it is not necessary to amend the claim or the drawings, and request that the Examiner withdraw this objection.

The Examiner additionally objected to Figure 1 for including large circular entities on the upper portion of Figure 1 because they appear to be protrusions rather than holes. In response, the applicants submit herewith Replacement Drawing Sheets, wherein the large circular entities have been deleted from the Figure 1. Accordingly, the applicants submit that this objection has been obviated.

Claim Rejections- 35 U.S.C. §112

The Examiner rejected claim 1, 2 and 4 under 35 U.S.C. §112, second paragraph as lacking antecedent basis for the terms “the vicinity”, “the lower end” and “the nasal passage” in claim 1; “the top lip” in claim 2; and “the septum” in claim 4. Claims 1 and 4 have been amended to include proper antecedent basis for certain objectionable terms, while claim 2 has been canceled.

With respect to the rejection to claim 1 based on the term “the vicinity”, the applicants respectfully submit the fact that that a term used in the claim has no antecedent basis does not necessarily mean that the term is indefinite. Rather, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Energizer Holdings Inc. v. Int’l Trade Comm’n*, 435 F.3d 1366, 77 USPQ2d 1625 (Fed. Cir. 2006). In present claim 1, the term “the vicinity” is a statement of proximity, not absolute location, and requires no antecedent basis for an understanding of the claim. For this reason, the applicants respectfully submit that claim 1 is not indefinite

for use of the term “the vicinity”, and respectfully request that the Examiner withdraw this rejection.

Claim Rejections- 35 U.S.C. §102

The Examiner rejected claims 1 and 4 under 35 U.S.C. §102 as anticipated by Congro (US 3,724,459). Claim 1 has been amended herein to incorporate the limitations of original claim 2, which was not rejected under this statute. Accordingly, the applicants submit that the rejection to claims 1 and 4 are now obviated, and respectfully request that they be withdrawn.

Claim Rejections- 35 U.S.C. §103

The Examiner rejected claims 2 and 3 under 35 U.S.C. §103(a) as obvious over Congro. The Examiner stated that it would have been obvious to one of ordinary skill in the art to place a hinge on longer side of the housing since it would have been less likely to fail due to extended use. The applicants respectfully traverse this rejection.

A *prima facie* case of obviousness requires that three basic criteria must be met. First, there must be some suggestion or motivation, either in the prior art or the knowledge of one of ordinary skill in the art, to modify the reference. Second, there must be an expectation of success. Finally, each and every claim limitation must be taught by the reference as modified. MPEP §2143. The applicants submit that there is no suggestion or motivation to modify Congro to place a hinge on the side of the housing.

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make

the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the instant case, a modification of the hinge and lid to Congro would not be possible in Congro's current construction because the lid would not be able to rotate around the hinge so as to cover and uncover the vertically pointing "protuberances". Moreover, the short-side hinge in Congro actually functions as a handle-like device when a user holds the inhaler to the nose during use. (See Figure 2). The proposed modification would clearly render this function inoperable, in addition to likely hindering its handling and usability. Therefore, there is no motivation to modify the reference as suggested by the Examiner.

The applicants additionally dispute the Examiner's contention that a hinge placed on a short side is more likely to fail than a hinge placed on the longer side. The Examiner has provided no factual basis for such a conclusion. It follows then that the Examiner has merely speculated as to the motivation of a person of ordinary skill in the art. The Examiner bears the initial burden of establishing a *prima facie* case of obviousness, and without factual support to base the conclusions made in the instant Office Action, the applicants respectfully submit that the *prima facie* case cannot be established. Accordingly, the applicants respectfully request that the rejections be withdrawn.

The applicants believe the claims are now in condition for allowance, and respectfully request such favorable action. If any issues remain, the resolution of which can be advanced through a telephone conference, the Examiner is invited to contact the applicant's attorney at the phone number listed below.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully requests that this be considered a petition therefore. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By /Mark D.Marin/

Mark D. Marin
Attorney for Applicants
Reg. No. 50,842
875 Third Avenue
18th Floor
New York, New York 10022
Tel. 212-808-0700